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| 09/194,025      | 02/12/99    | BOUQUET              | J XI/P6155US0       |

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EXAMINER

ZEMAN, R

ART UNIT

1645

PAPER NUMBER

11

DATE MAILED:

07/19/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**09/194,025**

Applicant(s)

**Bouquet et al.**

Examiner

**Robert A. Zeman**

Group Art Unit

**1645**



☒ Responsive to communication(s) filed on Apr 24, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-17 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-17 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Response to Amendment***

Amendment filed on 4/24/2000 is acknowledged. Claims 1-13 were amended. Claims 14-18 have been added. Claims 1-18 are pending and currently under consideration.

### ***Specification Objections Withdrawn***

The objection to the specification due to the lack of an abstract is withdrawn in light of the amendment thereto.

The objection to the specification based on the brief description of the Drawings is withdrawn in light of the amendment thereto.

### ***Claim Objections Withdrawn***

The objection to claims 2, 3, and 6-12 for the use of the phrase "characterized in that" is withdrawn in light of the amendment thereto.

The objection to claim 2 for the use of an improper period is withdrawn in light of the amendment thereto.

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***Claim Objections Maintained***

The objection to claims 4 for failing to introduce each claim with an article is maintained. Specifically, claim 4 has not been amended to overcome said objection.

***Claim Rejections Withdrawn***

The rejection of claims 4-13 under 35 U.S.C. 112, first paragraph, for failing to comply with 37 CFR 1.803-1.809 is withdrawn in light of the Statement by the Attorney of Record.

The rejection of claims 3 and 5 under 35 U.S.C. 112, second paragraph, for being indefinite by use of the phrase “derived from” is withdrawn in light of the amendment thereto.

The rejection of claims 4-13 under 35 U.S.C. 112, second paragraph, for reciting improper Markush language is withdrawn in light of the amendment thereto.

The rejection of claims 8 and 9 under 35 U.S.C. 112, second paragraph, for being indefinite by use of the term “preferably” is withdrawn in light of the amendment thereto.

The rejection of claim 8 under 35 U.S.C. 112, second paragraph, for being indefinite by use of the term “chronically” is withdrawn in light of the amendment thereto.

The rejection of claim 10 under 35 U.S.C. 112, second paragraph, for being indefinite by use of the phrase “overexpress one or more of the genes involved.....” is withdrawn in light of the amendment thereto.

The rejection of claim 12 under 35 U.S.C. 112, second paragraph, for being indefinite by use of the phrase “accelerate cell growth” is withdrawn in light of the amendment thereto.

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The provisional rejection of claims 1-13 on the grounds of obvious type double patenting over the claims of copending Application No. 09/194,020 is withdrawn in light of the filed Terminal Disclaimer (Paper No. 10).

The terminal disclaimer filed on April 24, 2000 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on Application No. 09/194020 has been reviewed and is accepted. The terminal disclaimer has been recorded.

The rejection of claims 1-13 under 35 U.S.C. 103(a) for being obvious over copending Application No. 09/194,020 is withdrawn in light of Applicant's argument which was persuasive

The rejection of claims 1-13 under 35 U.S.C. 102(b) as being anticipated by Guilhot et al (Oncogene 1993, Vol. 8, pages 619-624) is withdrawn in light of the amendment thereto.

***Claim Rejections Maintained***

The rejection of claims 1-3 under 35 U.S.C. 112, second paragraph, for being indefinite by use of the phrase "resistant to apoptosis" is maintained for reasons of record. Applicant's amendment to said claims is insufficient to overcome the objection.

The rejection of claim 6 under 35 U.S.C. 112, second paragraph, for being indefinite through the use of the phrase "they contain at least one expression cassette...." is maintained for reasons of record. While the amendment to the claim obviates the rejection with regard to use of the phrase "molecule of industrial relevance" it is insufficient to overcome the rejection with

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regard to the use of the phrase “they contain at least one expression cassette”. Since no particular expression systems are set forth such that one would be apprised of the scope of the claim, the rejection is maintained.

The rejection of claim 7 under 35 U.S.C. 112, second paragraph, for being indefinite through the use of the phrase “glycoprotein type” is maintained for reasons of record. While the amendment to the claim obviates the rejection with regard to use of the phrase “such as” it is insufficient to overcome the rejection with regard to the use of the phrase “glycoprotein type”. Since the amendment does not clarify what is meant by “glycoprotein type” it is still unclear what is the intended scope of the claim. Hence, the rejection is maintained.

The rejection of claims 8 and 10 under 35 U.S.C. 112, second paragraph, for being indefinite by use of the phrase “able to” is maintained for reasons of record. Applicant’s amendments to the claims (specifically claim 8) are insufficient to overcome the rejection.

The rejection of claims 10-12 under 35 U.S.C. 112, second paragraph, for being indefinite by use of the term “integrate” is maintained for reasons of record. Applicant’s amendments to the claims are insufficient to overcome the rejection. It is still unclear whether the cells integrate the vector into their genome or merely facilitate integration elsewhere.

The rejection of claim 11 under 35 U.S.C. 112, second paragraph, for being indefinite by use of the phrase “a gene encoding a viral receptor” is maintained for reasons of record. Applicant’s amendment to the claim is insufficient to overcome the rejection. It is still unclear

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whether the claim is referring to cellular receptors utilized by viruses or receptors on the virus itself.

The rejection of claim 13 under 35 U.S.C. 112, second paragraph, for being indefinite for the recitation of incomplete method step is maintained for reasons of record. Applicant's amendment to the claim is insufficient to overcome the rejection. Said method still refers to a single step and does not set forth positive active steps by which the method is to be performed.

#### *New Claim Rejections*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for avian cells which are immortalized, but untransformed, and resistant to apoptosis with the antiapoptotic gene bcl-2 integrated into their genome, does not reasonably provide enablement for avian cells which are immortalized, but untransformed, and resistant to apoptosis with an antiapoptotic gene **other than** bcl-2 integrated into their genome . The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

The specification describes the methods for transforming avian cells, for constructing plasmids containing the antiapoptotic gene bcl-2, and methods for integrating said plasmids into

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said cells. The specification is silent on what methods would be employed if an antiapoptotic gene other than bcl-2 were to be used. Nor does the specification give any direction as to what antiapoptotic genes, if any, might be used in lieu of bcl-2. Consequently, the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

***Conclusion***

**No claim is allowed.**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,



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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A. Zeman whose telephone number is (703) 308-7991. The examiner can be reached between the hours of 7:30 am and 4:00 pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, Donna Wortman, Primary Examiner can be reached at (703) 308-1032 or the examiner's supervisor, Lynette Smith, can be reached at (703)308-3909.



**DONNA WORTMAN**  
**PRIMARY EXAMINER**

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Robert A. Zeman

July 14, 2000